

UTILITY PATENT

B&D No. P-US-TN1444



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: **Roger Q. SMITH et al.**

Serial No.: **09/153,621**

Examiner: **T. Dinh**

Filed: **September 15, 1998**

Group Art Unit: **2841**

For: **HEAVY-DUTY AUDIO EQUIPMENT**

Assistant Commissioner for Patents
Washington, DC 20231

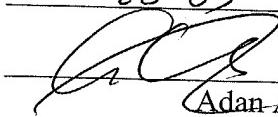
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APPEAL BRIEF

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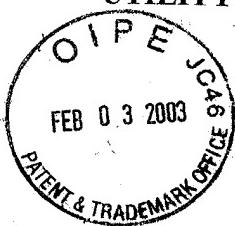
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Adan Ayala

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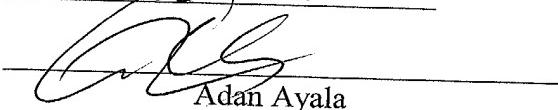
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Adan Ayala

Dear Sir:

I. INTRODUCTION

A final Office Action was mailed on November 7, 2002. In response to the final Office Action, a Notice of Appeal was mailed on January 3, 2003, for the above-identified application. The present appeal brief is being timely filed in triplicate, as required under 37 CFR § 1.192.

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II. REAL PARTY INTEREST

The real party in interest in the present case is Black & Decker Inc. An assignment transferring all rights to the present application and resulting patents was filed in the present application. The assignment was recorded on November 2, 1998 and can be found at Reel 9560, Frame 0625.

III. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences related to the present case are currently pending.

IV. STATUS OF CLAIMS

Claims 1-6 and 15-20 are currently pending in the present application.

Claims 1-6 are rejected and are presently appealed.

V. STATUS OF AMENDMENTS

No amendments were filed in response to the Final Office Action. None amended the claims.

VI. SUMMARY OF INVENTION

Pursuant to 37 CFR § 1.192 and MPEP § 1206, Applicant/appellant hereby provides a concise explanation of the inventions defined in the claims involved in the present appeal. This

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explanation refer to the specification by page and line number and to the drawings, as required by the CFR and the MPEP rules. However, the following explanation only refers to the embodiments disclosed in the specification and does not discuss alternative mechanisms that would be covered by the claims. Accordingly, the following explanation should not be used to limit the scope of the claims.

Independent Claim 1 calls for an audio equipment 10 comprising a housing 11 and an audio circuitry installed within the housing 11. Spec., p. 2, lns. 16-18. The audio equipment 10 also comprises a first protective bar 20 flexibly connected to the housing 11. Spec., p. 3, lns. 12-13.

Claim 2 is dependent upon Claim 1, and thus includes all the elements of Claim 1 described above. Claim 2 further defines that the audio equipment 10 further comprises a handle 21 attached to the first protective bar 20. Spec., p. 3, lns. 21-22.

Claim 3 is dependent upon Claim 1, and thus includes all the elements of Claim 1 described above. Claim 3 further defines that the audio equipment 10 further comprises a connector assembly 30 flexibly connecting the first protective bar 20 to the housing 11. Spec., p. 4, lns. 3-6.

Claim 4 is dependent upon Claim 3, and thus includes all the elements of Claim 3 described above. Claim 4 further defines that the connector assembly 30 comprises a flexible gasket 31. Spec., p. 4, lns. 6-8.

Claim 5 is dependent upon Claim 4, and thus includes all the elements of Claim 4 described above. Claim 5 further defines that the flexible gasket 31 is disposed between the first protective bar 20 and the housing 11. Spec., p. 4, lns. 8-10.

Claim 6 is dependent upon Claim 1, and thus includes all the elements of Claim 1 described above. Claim 6 further defines that the audio equipment 10 further comprises a second protective bar 20 flexibly connected to the housing 11. Spec., p. 3, lns. 12-13 & 20-21.

VII. ISSUE

Whether Claims 1-6 are anticipated under 35 USC § 102(b) over US Patent No. 4,480,809 (“Healey”).

VIII. GROUPING OF CLAIMS

For the § 102(b) rejection, Claims 1-6 stand together.

IX. ARGUMENT**Claims 1-6 are Patentable under 35 USC § 102(b) Over Healey.**

The Board should reverse the Examiner’s improper final rejection of Claims 1-6 under 35 USC § 102(b) based on Healey, as Healey does not disclose all the claimed elements.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union*

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Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In the present case, Healey fails to disclose at least two of the claimed elements.

Claim 1 calls for an audio equipment comprising a housing, an audio circuitry installed within the housing, and a first protective bar flexibly connected to the housing. Claims 2-6 are ultimately dependent upon Claim 1.

Admittedly, Healy discloses a fishfinder including a housing containing sonar circuitry, and that the housing is connected to a base 14. However, Healy does not disclose any audio circuitry. In addition, Healy does not disclose a first protective bar flexibly connected to the housing.

Applicants/Appellant will address each failure in separate sections.

A. Healey does not Disclose any Audio Circuitry.

In the Office Actions, the Examiner admitted that no audio circuitry was shown in Healey. Instead, the Examiner noted that the audio circuitry is inherent to the sonar.

It is true that an inherent disclosure of a prior art reference may be relied upon in the rejection of claims under 35 USC § 102(b). MPEP § 2112, at 2100-51 (8th ed., Aug. 2001). However, to establish inherence, “the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Accordingly, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic

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necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). However, the fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherence of that characteristic. *In re Rikckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

In other words, the Examiner must show that audio circuit is necessarily found in all fishfinders circa 1982, i.e., the filing date of Healy. Why in all fishfinders? Because if the feature is not present in all fishfinders, then the feature is necessarily present in fishfinders, and thus cannot be considered inherent to fishfinders. In addition, the Examiner must show that the audio circuitry is necessarily within the housing, rather than outside of the housing.

Rather than provide such proof, the Examiner argued that Healey discloses an instrument, which, according to Webster's, means "a device to product/perform [sic] a music." The Examiner then inferred that the Healey fishfinder had some audio card (and thus the claimed audio circuitry) to produce the sounds or music. Applicants/Appellant believe that the Examiner's inferential leap is invalid.

Evidence of this is the fact that many other instruments exist that do not have any audio circuitry. For example, according to Webster's,¹ "instrument" means, among other things, "utensil, implement (surgical ~s)." Thus, a scalpel, which is a surgical implement or instrument, is an instrument. Based on the Examiner's logic, all scalpels would have an audio card to

¹ Because the Examiner did not provide a complete citation to the Webster's Collegiate Dictionary, e.g., which one of the published ten editions is he quoting from, or provided a copy of the dictionary definition, Applicants/Appellant have not been able to verify the Examiner's allegations. Nevertheless, for the following definitional discussion, Applicants/Appellant refer to

produce sounds or music, as all instruments produce sounds. Applicants/Appellants pose that a scapel with an audio card is rarely found, if any do in fact exist.

The Examiner's mistake arose when the Examiner ignored all the other definitions and, rather than choose the most appropriate one, he selected the most convenient one. Webster's has multiple definitions for "instrument," including "1a: a means whereby something is achieved, performed, or furthered," "3: an implement used to produce music," "5a: a legal document," "a measuring device for determining the present value of a quantity under observation; ... a device (as for controlling, recording, regulating, computing) that functions on data obtained by such a measuring device," etc.

Applicants/Appellant submit that the Healey fishfinder instrument is neither a musical instrument nor a legal instrument. Instead, Applicants/Appellant believe that the primary definition, i.e., "a means whereby something is achieved, performed, or furthered," is the most relevant. In this case, the Healey fishfinder instrument is a means to achieve something, i.e., finding fish, or a measuring device for determining and/or computing the present value of fish underwater. Admittedly, these definitions are inconvenient to the Examiner's case as they do not suggest any audio circuitry, i.e., the missing claimed element. However, they are the most relevant to the present discussion. As such, arguing that the Healey fishfinder has an audio card because it is an instrument that can produce sound is incorrect.

To summarize, Applicants/Appellant had requested proof from the Examiner that audio circuitry was necessarily present in all circa-1982 fishfinders, thus making audio circuitry an

the Webster's Third New International Dictionary, with its definition of the word "instrument,"

inherent element in the Healey fishfinder. The Examiner failed to provide such evidence. Instead, the Examiner relied on the wrong definition of "instrument" to find such audio circuitry, whereas, under the primary definition of "instrument," no such audio circuitry is necessarily found.

Based on the foregoing, the Examiner has failed to show that the Healey reference discloses all the claimed elements. Therefore, Healey cannot anticipate Claims 1-6. Accordingly, the Board should reverse the improper rejection of Claims 1-6 based on Healey and allow the application.

B. Healey does not a Protective Bar Flexibly Connected to the Housing.

In addition to lacking the claimed audio circuitry, Healey fails to disclose a protective bar flexibly connected to the housing, as called for in Claim 1.

First of all, as disclosed in Healey, the base 14, which includes arm support 16, does not serve to protect the housing. For example, Applicants/Appellant note that base 14 is "adapted to rest on a support surface or be affixed to a support surface such as a portion of a boat or the like." Healy, col. 2, lns. 19-22. In other words, the base 14 only serves to support the fishfinder in place. Therefore, the base 14 is not a "protective bar" as called for in Claim 1. Thus, Healy cannot anticipate Claim 1 and its dependent claims.

Furthermore, base 14 is not flexibly connected to the housing as called for in Claim 1. Such arrangement is critical and advantageous, as evidenced by the declaration of Michael L.

as well as the copyright page, attached hereto as Appendix B.

O'Banion, a person of ordinary skill in the art, which was previously submitted in the present case and attached hereto as Appendix C.

According to Healy, housing 10 has a trunnion 26 which receives resilient washer 30. A knob 34 has a screw 36 threadingly engaged to trunnion 26. A second resilient washer 38 is disposed between knob 34 and base 14. Accordingly, base 14 is sandwiched between resilient washers 30, 38, as shown in FIG. 2 of Healey. To fix the angular position of housing 10 relative to base 14, knob 34 is tightened, compressing washers 30, 38, which provide enough friction accordingly. Because of this compression, base 14 and its component arm 16 are not flexibly connected to the housing. App. C, para. 12.

By contradistinction, Claim 1 requires "a first protective bar flexibly connected to the housing." Since Healy does not teach or suggest such feature, it cannot anticipate Claim 1 or its dependent claims.

Rather than address Mr. O'Banion's technical remarks, the Examiner ignores such remarks and alleges that Applicants'/Appellant's argument fails because Applicants/Appellant fail "to claim the contest provision [sic]" and that "[n]on [sic] of the claims 1-6 teach 'the protective bar is provided to protect the housing from being destroyed at a jobsite: (1), [sic] tools being dropped on the housing, or (2), [sic] the radio falling down.'"

While it is true that Claims 1-6 do not claim that the protective bar is provided to protect in those two specific situations, Applicants/Appellant note that such counter-argument misses the point. Applicants/Appellant have provided evidence that the base 14 is not flexibly connected to the housing. The Examiner has not questioned the substance of the evidence or provided any

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counter-argument or evidence against such point. Accordingly, the Board should follow the evidence and find that Healey does not disclose a protective bar flexibly connected to the housing.

Because such element is missing from Healey, it cannot anticipate Claims 1-6. Therefore, the Board should reverse the Examiner's rejection based on Healey, and allow the application.

X. APPENDICES

Applicants/Appellant has attached three appendices: (a) Appendix A--a copy of the claims involved in the appeal; (b) Appendix B--a copy of the definition "instrument" according to the Webster's Third New International Dictionary; and (c) Appendix C—a copy of the declaration of Michael L. O'Banion, which was previously filed in the present case.

XI. CONCLUSION

Based on the foregoing, Applicants/Appellant urges the Board to rule that Claims 1-6 are patentable over Healey, and allow the present application.

Respectfully submitted,



Adan Ayala
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Attorney for Applicants/Appellant

Appendices attached



APPENDIX A

1. An audio equipment comprising:
 - a housing;
 - an audio circuitry installed within the housing; and
 - a first protective bar flexibly connected to the housing.
2. The equipment of Claim 1, further comprising a handle attached to the first protective bar.
3. The equipment of Claim 1, further comprising a connector assembly flexibly connecting the first protective bar to the housing.
4. The equipment of Claim 3, wherein the connector assembly comprises a flexible gasket.
5. The equipment of Claim 4, wherein the flexible gasket is disposed between the first protective bar and the housing.
6. The equipment of Claim 1, further comprising a second protective bar flexibly connected to the housing.

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APPENDIX B

Webster's Third New International Dictionary OF THE ENGLISH LANGUAGE UNABRIDGED

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